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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,166	12/30/2003	Matthew A. Szymanski	381.047	7821

7590

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EXAMINER

NGUYEN, TRI V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,166

Applicant(s)

SZYMANSKI, MATTHEW A.

Examiner

Tri V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-17 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-17 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 11, 2006 has been entered.

Response to Amendment

2. In the amendment filed on September 11, 2006, Claims 1, 13 and 21 have been amended and Claims 12 and 18-20 have been cancelled. The currently pending claims considered below are Claims 1-11, 13-17 and 21.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. There is no description of any dye within the scope of the formula presented in claim 21 critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant provides a general formula but does show even one instance of a dye included in the formula in claim 21. There is no indication that applicant had in his possession at the time the invention was made, the claimed process wherein even one dye within the scope of

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the claimed formula was used. For the description to be enabling there need to be a teaching of which dyes fall within the general formula, a listing or Color Index names or numbers, a method of formulating the dyes, or some other indication of dyes falling within the scope of the formula, and a description or example of using at least one dye falling within the scope of the claimed formula.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 14 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 14 recite the limitation "the method of claim 12" in the first line. There is insufficient antecedent basis for this limitation in the claim as claim 12 has been cancelled..

Regarding claim 21, in the first place, a pigment is not a dye, though they are both colorants. See specification at page 4 line 4 "dyestuff or pigment" or page 1 line 27 "dyestuff and/or pigment" Accordingly the dye of claim 21 does not further limit the "pigment" of claim 1.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-5, 9-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al., US RE. 24,554.

Example 1 and 2 in columns 3 and 4. disclose paper (a cellulosic substrate) which has been dyed with a colorant composition comprising a pigment, thickener and a solvent and then coated with an overcoating. Regarding claim 3, the colorant in both examples are provided as dispersions, indicating that the colorants are in the form of particles and thus were provided in the form of dry coloring matter, meeting the limitation claim 3. Regarding claim 4, the rubber which acts as thickener is provided in amounts of approximately 1 % in example 1 and approximately 3% in example 2. The pigment is present in examples 1 and 2 in an amount of about 17%, meeting the limitations of claims 9 and 10. Regarding claims 11 and 15, in the examples described above, the application rate of the colorant composition or overcoat is described in terms of the thickness of the applied coating and not in terms of the weight of the substrate as claimed. It would have been obvious to the man having skill in the art at the time the invention was made to adjust the coating thickness so that the paper is not overloaded and still is useful for his intended purpose, and it is seen that the spreader knife or bar used in the examples is readily adjustable to provide any coating weight needed. See example 1 wherein the coating layers are applied at various thicknesses. (col 3 lines 50 and 58). In example 15 in col 13, the colored paper may also be coated with a treating composition comprising a methyl methacrylate polymer, meeting the limitation of claim 13. The overcoat comprises latex crepe rubber meeting the limitations of claim 14. Regarding claims 16 and 17, the coatings are applied by means of a spreader knife or bar. In the examples described above, the overcoat comprises a latex rubber.

The "consisting essentially of" language of the present claim does not necessarily exclude the colorant from the overcoat because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80

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USPQ 448. Applicants have not submitted factual evidence showing that the colorant in the overcoat materially affects the instant invention.

7. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. as applied to claim 5 above, and further in view of The Dow Chemical Company, EP 1,176,255 A1.

Clark et al. disclose the method of claim 5 but do not explicitly disclose the nature and quantities of the thickener of claims 6-8. In an analogous art, Dow discloses a pigmented coating composition comprising a starch dispersion as binder which is used as a coating color for paper. See abstract. Table 1 on page 7 shows an aqueous precoat formulation comprising calcium carbonate pigment, latex, two different starches and CMC as binders (thickeners). See also claim 1 on page 10. Therefore, it would have been obvious to the man having skill in the art of papermaking to apply the specific thickeners in the amounts as taught by The Dow Chemical Company in the method of Clark et al. with reasonable expectations of success since Clark et al. invite the inclusion by reciting the use of a thickener in the coloring method.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. as applied to claim 1 above, and further in view of Degen et al. (US 4,276,415 hereon referred to as Degen '415) or Degen et al. (US 4,212,644 hereon referred to as Degen '644).

Clark et al. disclose the method of claim 1 but do not explicitly disclose the use of the claimed dye. In an analogous art, Degen '415 or Degen '644 disclose a dye for coloring paper-based materials having the formula of claim 21 (abstract). Therefore, it would have been obvious to the man having skill in the art of papermaking to apply the specific dye as taught by Degen '415 or Degen '644 in the method of Clark et al. with reasonable expectations of success since Clark et al. invite the inclusion by reciting the use of a dye in the coloring method.

Response to Arguments

9. Applicant's arguments with respect to claims 1-11, 13-17 have been considered but are moot in view of the new ground(s) of rejection.

The applicant's argument regarding the claim language "consisting essentially of" has been addressed in the rejection above. In summary, the "consisting essentially of" language does not necessarily exclude the colorant from the overcoat because "consisting essentially of" renders the composition open to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not submitted factual evidence showing that the colorant in the overcoat materially affects the instant invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PRIMARY EXAMINER